

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER A. GRUBER et al.

Appeal No. 1998-3207
Application No. 08/518,874

ON BRIEF

Before McQUADE, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-13 and 18-21. Claims 14-17 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claim 2 has been canceled.

We REVERSE.

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BACKGROUND

The appellants' invention relates to an apparatus for injection molding a liquid into a plurality of cells in a plate for solidification therein. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dreher	3,470,848	Oct. 7, 1969
Bird	3,735,729	May 29,
1973		
Timson	3,749,053	July 31, 1973
Norton	3,797,281	Mar. 19, 1974
Pasch et al.	4,140,470	Feb. 20, 1979
(Pasch)		
Bogardy	4,968,534	Nov. 6, 1990
Wieser	5,059,112	Oct. 22, 1991
Ference et al.	5,244,143	Sep. 14, 1993
(Ference)		

Claims 1, 3-13 and 18-21 stand rejected under 35 U.S.C.

§ 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.¹

Claim 18 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Bird, Timson, Pasch or Wieser.

Claims 1, 3-9, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ference taken together with either Bogardy or Norton, and further in view of either Pasch or Wieser.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ference taken together with either Bogardy or Norton, and further in view of either Pasch or Wieser as applied above, and further in view of Dreher.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

¹ The examiner inadvertently included canceled claim 2 in the statement of this rejection set forth in the answer.

rejections, we make reference to the answer (Paper No. 19, mailed April 23, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed November 24, 1997), supplemental brief (Paper No. 18, filed March 13, 1998) and reply brief (Paper No. 20, filed May 4, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1, 3-13 and 18-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty,

a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Furthermore, appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we have reviewed the specific objections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal (answer, pp. 5-7). After conducting this review, we find ourselves in agreement with the position set forth by the appellants in the briefs that the claims under appeal are not indefinite for the reasons set forth by the examiner. Clearly the claimed apparatus is intended "for injection molding a liquid into a plurality of cells in a plate for solidification therein" since the

appellants disclose (specification, p. 11) that a conventional pump 32 effects a slight pressurization in liquid reservoir 24a for injection molding small cells. With regard to the other phrases found objectionable by the examiner we simply do not agree with the examiner. In that regard, we note that the mere breadth of a claim does not in and of itself make a claim indefinite.²

The anticipation rejections

We will not sustain the rejection of claim 18 under 35 U.S.C. § 102(b) as being anticipated by Bird, Timson, Pasch or Wieser.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v.

² Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789
(Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 18 recites an apparatus for injection molding a liquid into a plurality of cells in a plate for solidification therein comprising, inter alia, means for evacuating gas from cells, means for injecting liquid into the cells, and means for linking the evacuating and injecting means at each of the cells so that surface tension of the liquid prevents evacuation of the liquid injected into the cells while allowing evacuation of only gas from the cells.

The appellants argue in their briefs that claim 18 is not anticipated by Bird, Timson, Pasch or Wieser since they do not disclose the claimed "means for linking." We agree.

As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the USPTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The court's holding in Donaldson sets a limit on how broadly the USPTO may construe means-plus-function language under the rubric of "reasonable interpretation." Per Donaldson, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the USPTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

The structure described in the appellants' specification (see pp. 7-10) corresponding to the "means for linking" is the shallow slot or recess 30 formed in the bottom surface 16b of the injection head 16 and extending axially between the vacuum slot 18 and the injection slot 20.

We have reviewed the teachings of Bird, Timson, Pasch and Wieser but fail to find any teaching therein of the claimed

"means for linking." With regard to Bird, Pasch and Wieser, we see no structure therein that would be equivalent to the structure disclosed by the appellants. Furthermore, with respect to Bird, Pasch and Wieser, the examiner appears to be impermissibly reading the same structure that constitutes part of the claimed "means for evacuating" as the "means for linking." With regard to Timson, it is our view that the examiner has not established that Timson's gap between the upper coating lip 38 and the web (see column 4, lines 40-56) is an equivalent to the structure disclosed by the appellants. In our view, it is not.

The obviousness rejections

We will not sustain the rejection of claims 1, 3-9 and 18-20 under 35 U.S.C. § 103.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed

invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. In fact, the advantages of utilizing a "means for linking" is not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to

the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the "means for linking" limitation of the claims under appeal is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 1 and 18, and of dependent claims 3-9, 19 and 20.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-13 and 18-21 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claim 18 under 35 U.S.C. § 102(b) is reversed; and the

decision of the examiner to reject claims 1, 3-9 and 18-20
under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
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